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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,623	01/31/2002	Dov Borovsky	UF-216C1	4742

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EXAMINER

WOITACH, JOSEPH T

ART UNIT PAPER NUMBER

1632

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,623

Applicant(s)

BOROVSKY ET AL.

Examiner

Joseph T. Weitach

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71-140 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 111-124 and 127-140 is/are allowed.
- 6) ☒ Claim(s) 71-110, 125 and 126 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

This application filed January 31, 2002, is a continuation in part of application 09/295,849, filed April 21, 1999, now abandoned.

Applicants' amendment filed March 22, 2004, has been received and entered. The specification has been amended. Claims 1-70 have been canceled. Claims 71-140 have been added. Claims 71-140 are pending .

Election/Restriction

Applicant's election of Group II, claims 1-10, 14-64, 66-70, drawn to methods and compositions for pest control wherein NPF peptides are administered to pests via recombinant cells expressing the peptides with traverse was acknowledged. The election of a species of NPF polypeptide was withdrawn because it was not considered to be an undue burden to examine the genus of NPF peptides taught in the specification.

Newly added claims 71-140 are drawn to a method of controlling a pest comprising administering a cell which produces an effective amount of a NPF peptide and methods of making are currently under examination.

Specification

The sequence listing and CRF filed March 22, 2004 have been processed and entered. The application is now in sequence compliance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims previously rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention, and as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention have been cancelled.

To the extent that the rejection would apply to the newly added claims, it is noted that all the pending claims recite specific SEQ ID NOs instead of general terms or functional properties of a pesticidal peptide. The instant specification teaches that each of the claimed sequences have the inherent property of being pesticidal peptides therefore would not be subject to the previous rejections.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 71-110, 125, 126 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically:

Claim 71 is vague and incomplete in what is encompassed in the recitation of “a pesticidally effective amount”. The amount of expression would be dependent on the cell type and promoters used, and the effective amount would have to be determined based on the pest that is being targeted. The metes and bounds of the claim are indefinite because an effective amount can only be determined in a specific context of the elements used for expression and the pest being targeted.

Claims 78, 85, 86, 125, 126 are confusing in the limitations set forth because it is unclear if this is an additional property or simply an inherent property of the specific sequences. If it is an inherent property it constitutes only a description and would not further limit the claim on which it depends. If it is a property of only some of the recited sequences, more clearly setting forth the relationship of the specific sequences and their properties would address the basis of the rejection.

Claim 99 is incomplete because the method does recite any functional promoter nor even require that the peptides be made, only that the sequence encoding the peptide be provided to the cell. More clearly indicating a functional relationship with a promoter or including a step where the peptide is made would address the basis of the rejection.

Conclusion

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Claims 11-124, 127-140 are allowed. The remaining claims are free of the art of record, however they are subject to other rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (571) 272-0734.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach


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